

## **R E M A R K S**

Review, reconsideration and allowance of claims 1-17 are respectfully requested.

### **The Present Invention**

The present invention concerns a gift package for holding a product, such as a flashlight or a medallion, in a tray within an outer package having a decorative flap such that the product can be given as a gift. The gift product is held in a tray that slides into the outer package body. The tray provides stiffness to the overall packaging such that the package has depth and rigidity. The tray is pushed into the outer package body through one of two oppositely located side openings. The side openings are not associated with the hinged outer flap that covers the outer package when in a default first position. The tray is maintained within the outer packaging by friction, while it can be independently removed from the package without opening any package flaps or covers. The outer package comprises a window or opening such that the product can be seen when the flap is in a second, open, position. As claimed, the outer flap is in contact relationship with the body of the package in the first default position and requires no locking means (such as a tab or Velcro® or other locking means) to keep the top in contact relationship with the body of the package. The outer flap is not used in the present invention to hold the gift product within the package body.

### **The Cited Art; Specifically the Sylvester Reference**

The Office Action has rejected claims 1, 2, 4-8 and 10-16 under 35 U.S.C. Section 103(a) as being unpatentable over Sylvester (U.S. Patent No. 5,794,631) in view of Stearns (U.S. Patent No. 5,469,965) or Saye (U.S. Patent No. 5,575,384). The Sylvester disclosure clearly notes that the invention is designed to be a simplified means of quickly and decoratively packaging a *rigid*

item of a particular size. Sylvester demonstrates, in the disclosure, that the packaging is particularly related to packaging items that are themselves rigid and require only a minimum of cover, such as an audio or video cassette. Because the items to be packaged are rigid, packaging can be minimized so that it is easily folded and stored and quickly assembled for use. As noted by Sylvester in column 1, lines 54-60 and column 2, lines 7 - 14, of the '631 patent:

Therefore, it is a principal object of the present invention to provide a decorative, pre-formed, *easily employed* gift holding system constructed for securely receiving and holding standard dimensioned products for enabling the product to be securely retained and easily presented to another as a gift ***without requiring separate wrapping or a separate container.*** (emphasis added)

\* \* \*

Another object of the present invention is to provide a decorative, pre-formed gift holding system having the characteristic features described above *which is capable of being folded in a generally conventional manner for ease of storage*, while also being quickly and easily formed into the desired configuration for receiving and holding the particular gift. (emphasis added).

### Sylvester Teaches Away From Use of a Tray

Clearly, the packaging of Sylvester is designed for quick deployment from a flattened stored position to use with a gift that is of a particular size and rigidity. Such packaging is designed to obviate the need for any other packaging materials or containers ("without requiring ... a separate container"), such as a tray or other loose or shaped protective materials. The inclusion of an extra tray or other storage means would undermine the paramount features of easy storage and quick assembly that Sylvester teaches.

The inclusion of a tray (such as the tray claimed in the present application) to provide rigidity is taught away from in Sylvester -- the package is designed for use without using "a

separate container". The combination, therefore, of references that teach the use of a tray with Sylvester would not make the device of the present invention obvious, as the main reference teaches away from any such combination.

### **Sylvester Employs Locking Means to Keep Its Package Closed**

The Examiner has noted that Applicant's arguments with respect to the use of locking means in Sylvester are not persuasive. However, the Examiner may be missing some key elements of the Sylvester device due to the confusing manner in which Sylvester is disclosed.

The box of the main cited reference, Sylvester, requires the use of a locking means for keeping the cassette (31) in place within the package. The Sylvester package can hold a cassette (or other rigid and specifically shaped -- read: rectangular -- item) in place only when the cover flap (35) is folded over the main body of the box and the cover is held in place. This is because intermediate section 36 (which is an end panel) is only in place when cover 35 is folded over the main body of the package (See Fig. 2 of Sylvester) and can remain in place to hold a cassette 31 only when cover 35 is locked. As noted in the Sylvester specification, at col. 3, lines 10-26 and col. 3, lines 39-58:

By employing this preferred construction, a gift or product holding zone is created which is open on two, juxtaposed side edges. *In order to assure that any gift or product positioned in the holding zone of the central portion of the pre-formed gift or product holding system of the present invention is securely and safely retained therein, flap closure means are formed along at least one of the open side edges of the central portion.* (emphasis added)

\* \* \*

In the preferred construction, the pivotable panel is mounted to the panel edge defining the sole remaining open zone of the central portion. *In addition, the intermediate centrally disposed panel member (36) of the*

*pivotal portion is dimensioned for overlying the sole remaining open end of said central portion, forming a closure therefor.* In this way, complete closure of the central portion is attained and a fully assembled, easily completed product retaining system is realized, with the desired product securely retained within the central portion thereof and a movable panel forming a decorative or message delivery member. (emphasis and numeration added)

*In order to further enhance the secure closure of the product holding system of the present invention, fastening means (40) are preferably mounted on the outwardly facing surface of the top panel member of the central section which securely engages with the pivotal portion when placed in overlying contacting interengagement therewith. In this way, secure sealing of the entire product holding system is realized and an aesthetically pleasing, visually stimulating and event enhancing product holding system is attained.* (emphasis and numeration added)

Therefore, as noted in the specification (above) fastening or locking means (40) is only "optional" if the user wants to keep the cassette within the package -- that is, if no locking means is employed, the package remains open, allowing the product to fall out, or shift, when it is moved. Clearly, unless the Sylvester package is meant to remain stationary, some means must be employed to lock flap (35) down or the package will cease to function to hold the item inside.

The use of the fastening means then is truly not optional.

As presently claimed, the cover of the gift package of the present invention is disposed to remain in a first closed position (that is the flap is down against the body of the package) in contact relation to the outer cover of the inner compartment formed by the first and second panels without locking means. The item held within the packaging of the present invention is not held in place by this cover or any adjacent flaps. The outer flap of the present invention covers the main body of the package but the product is removed by pushing the tray from a secondary opening not directly covered by the flap. The flap in the present invention is not the part of the packaging holding the product, as is the case with all of the art cited by the office action – it is in

fact not locked down at all and is merely at rest adjacent the main body of the package. As presently claimed, including the limitation that there is contact in the default position and that the package has no locking means, the present invention is distinct from all of the cited references. All of the other cited references require some sort of locking means to keep the product within the package.

**The Other Cited References Do Not Teach the Present Invention**

With respect to Stearns and Saye, neither reference adds teachings which would make the present invention obvious in view of Sylvester. The teaching in Stearns and Saye of a tray would not have made the present invention obvious as there is no need to add a tray to the teaching of Sylvester as the product (31) being placed in the packaging of Sylvester fits within the entire cavity (30) provided to hold the product. Further, rigidity provided by a tray is unnecessary as a cassette tape inherently provides rigidity. No person having skill in the art would consider using a tray, as shown in Stearns and Saye, to provide rigidity in Sylvester where the cassette by itself provides all the rigidity needed. **Adding extraneous trays to packaging adds to the cost of the packaging, adds weight which increases the costs of shipping such packages, adds time to the assembly of a package and is in general taught away from in Sylvester.** Accordingly persons having skill in the art would be more inclined to remove elements of packaging rather than adding elements.

Regarding arguments concerning claim 6 and 7, since the underlying disclosure is not taught by the combination of the cited references, the inclusion of a cut-out or a window in Sylvester would not make the present invention obvious. With respect to the argument concerning claim 13, Sylvester does not teach a tray; the package of Sylvester directly holds the

object (a cassette tape). The cassette tape could not be modified to hold a flashlight or medallion as such would be a nonsensical result.

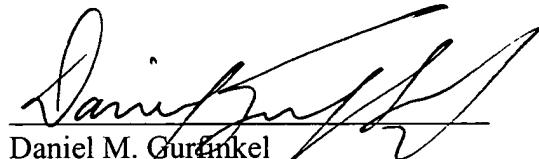
The Office Action has rejected claims 3, 9, 12 and 17 under 35 U.S.C. Section 103(a) as being unpatentable, as above, and in view of Heuer et al. (U.S. Patent No. 4,739,353) or Applebaum et al. (U.S. Patent No. 5,409,105). These references add nothing further to Sylvester to make the present invention obvious. Sylvester, as explained above does not include a tray and the “flap” of Sylvester is used, along with locking means, to keep the item held by Sylvester in place. In sharp contrast, and as noted above, as presently claimed the device of the present invention needs no locking means as the product carried is not held in place by the flap.

**Reconsideration and Allowance Requested**

Applicant hereby respectfully requests reconsideration and continued examination. Throughout the prosecution of this application a sincere effort has been made to overcome the rejections made and to place the application in allowable condition. A notice of appeal is being filed concurrently herewith. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

In view of the foregoing remarks and amendments, it is believed that the subject application is now in condition for allowance, an early Notice of Allowance is respectfully requested.

Respectfully submitted,



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